

REMARKS

Claims 1, 6, 8, 12, 14 - 15, 17 - 18, 20, and 23 have been amended. No new matter has been introduced with these amendments, all of which are supported in the specification as originally filed. Claims 1 - 10, 12 - 20, and 22 - 23 remain in the application.

I. Rejection under 35 U.S.C. §103

Paragraph 3 of the Office Action dated October 20, 2005 (hereinafter, "the Office Action") states that Claims 1 - 2, 8 - 9, and 15 - 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent 6,415,982 to Bridgelall et al. (hereinafter, "Bridgelall").

Paragraph 4 of the Office Action states that Claims 3 - 7, 10, 12 - 14, 17 - 20, and 22 - 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bridgelall in view of U. S. Patent 6,554,187 to Otto. These rejections are respectfully traversed.

Applicant has amended her independent Claims 1, 8, and 15 to clarify that the "at least one items" referenced in the final limitation are the "possessed" items and to use the term "purchased" rather than "presented for purchase".

Referring first to independent Claims 1, 8, and 15, Applicant notes that the Office Action refers to the shopping tote 86, which *contains items* to be purchased, for teaching the limitation of "storing the customer identifier in an item-identifying RFID tag ...". This claim language, as amended herein, clarifies that the tag of interest is "affixed to each of at least one items purchased in a current transaction". Bridgelall's shopping tote is not being purchased. Instead, in

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Bridgelall, items 85 are being purchased, and Bridgelall teaches that those items use bar codes 14 (and that a bar code reader 10 is provided on his counter 87; see col. 6, lines 17 - 18). Information cannot be stored into this bar code on items 85, as is well known. Accordingly, it is clear that nothing (and in particular, no customer identifier) is being "stor[ed] ... in an ... RFID tag affixed to each of at least one items purchased ..." (Claim 1, lines 4 - 5, emphasis added), in contrast to the limitations of Applicants' Claims 1, 8, and 15.

Furthermore, the Office Action states that Bridgelall's RFID tag 88 "is capable of subsequently be[ing] searched" (Office Action, p. 3, lines 16 - 17; emphasis added) and "is capable of achieving the claimed use of the item-identifying RFID tag" (Office Action, p. 6, lines 1 - 2; emphasis added). Applicant respectfully notes that what something "is capable of" is not the test for obviousness (and that this suggests prohibited *hindsight* analysis). See Section 706.02(j) of the MPEP, "Contents of a 35 U.S.C. 103 Rejection", which states the requirements for establishing a *prima facie* case of obviousness under this statute. As noted therein, three criteria must be met. These criteria are (1) a suggestion or motivation, found either in the references or in the knowledge generally available, to modify or combine the references; (2) a reasonable expectation of success; and (3) the combination must teach all the claim limitations. The three requirements for establishing a *prima facie* case of obviousness are also stated in MPEP §2142, "Legal Concept of *Prima Facie* Obviousness", and MPEP §2143, "Basic Requirements of a *Prima Facie* Case of Obviousness". Bridgelall does not teach storing information into RFID tags of purchased items, and in particular, does not teach storing a customer identifier therein, and the Office Action fails to provide a proper motivation for

modifying the reference.

Applicant also disagrees with the assertion on p. 2, paragraph 3, lines 9 - 10 of the Office Action, which states that Bridgelall's system "obviously" includes a means for storing the customer identifier into the RFID tag 88 of shopping tote 86. However, that point is moot in view of the above-noted distinctions between Applicant's claimed invention and Bridgelall's teachings.

Applicant therefore respectfully submits that her independent Claims 1, 8, and 15 are patentable over Bridgelall. Dependent Claims 2 - 3, 9 - 10, and 16 - 17 are therefore deemed patentable over Bridgelall by virtue of (at least) the allowability of the independent claims from which they depend.

With regard to independent Claims 4, 12, and 18, neither Bridgelall nor Otto teaches "searching ... an item-identifying RFID tag affixed to [each item possessed by the shopper] to determine whether the customer identifier from the customer loyalty card was previously stored therein during a particular purchase transaction" (Claim 4, lines 4 - 6, emphasis added). The Office Action refers (on p. 4, lines 7 - 12) to Otto's system 10 and label 12, as well as col. 1 lines 43+ and col. 2, lines 42+. However, Applicant respectfully submits that Otto has no teaching of a customer identifier that was previously read from a customer loyalty card being found (i.e., searched for) in the RFID tag of an item, in contrast to Applicants' Claims 4, 12, and 18.

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In addition, Otto teaches that "purchase information" is not even checked unless the item is from a different store than the store in which the shopper is presently located. See Fig. 2, where the "Same Store?" test 50 must have a negative response before looking at purchase information 52. See also col. 2, lines 47 - 50.

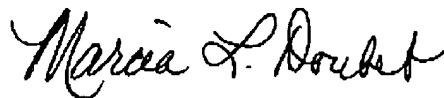
Thus, independent Claims 4, 12, and 18 are deemed patentable over the references. Dependent Claims 5 - 7, 13 - 14, 19 - 20, and 22 - 23 are therefore deemed patentable over the references by virtue of (at least) the allowability of independent Claims 4, 12, and 18.

Applicant therefore respectfully requests that the Examiner withdraw the §103 rejections.

II. Conclusion

In conclusion, Applicant respectfully requests reconsideration of the pending rejected claims, withdrawal of all presently outstanding rejections, and allowance of all remaining claims at an early date.

Respectfully submitted,



Marcia L. Doubet, Attorney for Applicant
Reg. No. 40,999

Customer Number for Correspondence: 43168
Phone: 407-343-7586
Fax: 407-343-7587

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